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Application No. 10/762,240
Amendment dated
Reply to Office Action of November 7, 2006

Docket No.: 215407-106338

REMARKS

Claims 26-29 and 34-63 are currently pending. By this amendment, Applicant amends claim 26, 34-38, 40-41 and cancels claims 30-33. New claims 46-63 are added. Favorable reconsideration is respectfully requested in light of the foregoing amendments and the following remarks.

I. Formal Matters

Claim Numbering

Applicant notes that claims 26-44 were previously listed as pending. Applicant points out that two claim 41's were presented in the previous amendment; and claims 26-45 were actually pending in that amendment. Applicant corrects the numbering through this amendment.

II. Claim Rejections Under 35 USC § 102 (e)

The Office action rejected claims 26-44 (i.e., Claims 26-45) under 35 U.S.C. §102(e) over Coffey et al. (U.S. Patent No. 6,830,443). In light of the amendments to the claims and the following remarks, the rejection is respectfully traversed.

A. Applicant has amended independent claim 26 to include the subject matter of previously-pending dependent claims 30 and 31. Amended claim 26 requires, *inter alia*, "*a flexible portion extending from the flange portion that is adapted to be compressed by a lid of a filter housing, wherein the flexible portion includes a pair of flexible flange portions that extend obliquely in divergent directions from the flange portion.*"

Applicant respectfully indicates neither Coffey nor the art of record discloses the limitation of "*flexible flange portions that extend obliquely in divergent directions from the flange portion.*" Applicant submits that under the "Allowable Subject Matter" header on page 3 of the 7/21/06 Final Office Action, it was indicated that the above limitation included allowable subject matter.

Although the current Office Action indicates that the subject matter of previously-pending dependent claims 30 and 31 is anticipated by the newly cited art, Applicant is not able to identify basis for the rejection in the current Action; nor can Applicant find basis for the

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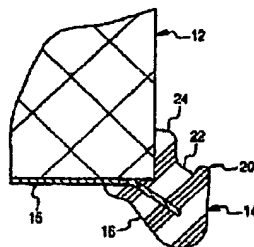
rejections in the art relied on by the Examiner. Coffey simply does not disclose, teach or suggest the foregoing structure either alone or in permitted combination with any of the art of record.

To anticipate a claim, the reference must teach every element of the claim. *"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."* See M.P.E.P. §2131 (8th Ed. 5th Rev.). Applicant, therefore, respectfully submits that claim 26 (as it incorporates structure not found in the prior art) is therefore allowable over the applied art. Claims 27-29 and 34-45 depend directly or indirectly from Claim 26 and also allowable over the applied art for the same reasons. Withdrawal of the rejection to Claims 26-29 and 34-45 is respectfully requested.

B. Claim 36 recites, *inter alia*, "a rigid frame-bonded to the clean side face, wherein the rigid frame is bonded to a perimeter of the clean side face to form a flange portion integral with the filter media; and a seal bonded to the rigid frame, wherein the seal is bonded to a perimeter of the rigid frame to form a seal flange portion integral with the rigid frame." (emphasis added) Although the Office Action indicates that the subject matter of claim 36 was anticipated by the applied prior art, Applicant is unable to locate any disclosure of such in Coffey.

Applicant directs attention to page 2 of the Office Action, which only refers to a filter media (12 in Coffey) and a seal (14 in Coffey); as such, Applicant notes that Coffey does not disclose, teach, or suggest a rigid frame bonded to any filter, media perimeter as recited in claim 36. The Action is notably deficient of any passages or support that validates this rejection. Figure 5 of Coffey is shown below for convenience.

Fig. 5



Assuming, *arguendo*, that '15' of Figure 5 in Coffey is interpreted as the Office Action as the claimed rigid frame, this so-called frame extends away from the filter and is certainly not

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bonded to any perimeter. Claim 16 recites "*wherein the rigid frame is bonded to a perimeter of the clean side face* (emphasis added)."

To anticipate a claim, the reference must teach every element of the claim. "*A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.*" See M.P.E.P. §2131 (8th Ed. 5th Rev.).

Applicant submits that Coffey alone or in permitted combination with the art of record does not teach or suggest all of the claim limitations as recited in independent Claim 36. Claim 36 should be allowable. Withdrawal of the rejection to claim 36 is solicited.

C. Claim 37 recites, *inter alia*, "*injecting a second material directly onto a perimeter of the clean side face to form a rigid frame; and injecting a third material directly onto the rigid frame to form a flange portion of a seal.*" This rejection should be withdrawn for at least the same reasons pertaining to claim 36. Moreover, Applicant is unable to locate the teachings, in Coffey, of two materials injected and bonded to the filter media. Coffey only teaches the step of molding a seal portion to the filter media: "*a polyurethane material is poured into the mold and allowed to cure about the pleats 12'.*" See col. 4, lines 45-47 of Coffey. Applicant is unable to find any mention in Coffey of injecting/molding a material in the mold tool to form a rigid frame and then injecting a seal material over the injected/molded rigid frame material.

To anticipate a claim, the reference must teach every element of the claim. "*A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.*" See M.P.E.P. §2131 (8th Ed. 5th Rev.). Because Coffey alone, or in permitted combination with the art of record, fails to teach or suggest all of the claim limitations as recited in independent Claim 37. Claim 37 is therefore allowable over the applied art. Withdrawal of the rejection to claim 37 is respectfully requested.

III. New Claims 58-63

To expedite analysis of the new claims, Applicant respectfully outlines the subject matter of the new claims as follows.

1. New claims 46 - 51

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Claim 46 substantially incorporates the subject matter of previously-pending claims 26, 30, and 32. Claims 47-51 substantially incorporate the subject matter of previously pending claims 27-29, 34, and 35.

Independent claim 46 recites *"a flexible portion extending from the flange portion that is adapted to be compressed by a lid of a filter housing, wherein the flexible portion includes a U-shape portion having a first leg and a second leg, and wherein, the U-shape portion extends toward the lid."* Although the Office Action summarily indicated that the subject matter of previously-pending dependent claims 30 and 32 was anticipated by the applied prior art, Applicant is unable to identify basis for the rejection in the Action; nor can Applicant find basis for the rejections in the art relied on by the Examiner. Coffey alone or in permitted combination with any art of record does not disclose, teach or suggest the foregoing structure. Allowance is therefore solicited.

2. Claims 52 - 57

Claim 52 substantially incorporates the subject matter of previously-pending claims 26, 30, and 33. Claims 53-57 substantially incorporates the subject matter of previously pending claims 27-29, 34, and 35.

Independent claim 52 recites *"a flexible portion extending from the flange portion axially compressible by a lid of a filter housing, wherein the flexible portion includes a bulb seal defining a void."* Although the Office Action summarily indicated that the subject matter of previously-pending dependent claims 30 and 33 was anticipated by the applied prior art, Applicant is unable to identify basis for the rejection in the Action; nor can Applicant find basis for the rejections in the art relied on by the Examiner. Coffey does not disclose, teach or suggest the foregoing structure either alone or in permitted combination with any of the art of record.

3. Claims 58 - 63

Claim 58 recites the limitation of *"a thermoplastic vulcanizate seal attached to the corner of the pleated filter media and extending over at least a portion of the end and at least a portion of the side, wherein the seal extends over at least a portion of the first*

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planar face." Applicant respectfully submits that this limitation is not supported by Coffey.

In addition, Applicant also has considered the teachings of U.S. 3,397,518 to Rogers ("Rogers") and U.S. 3,659,896 to Smith et al. ("Smith"). Applicant respectfully points out that Rogers and Smith were considered by the Examiner in the prosecution of parent application serial number 10/404,109 in the Non-Final Office Action dated 1/19/06, which is related to the present invention.

Applicant respectfully submits that neither one of Rogers or Smith, or, alternatively, the combination of the teachings of Rogers and Smith renders the claimed limitations recited in claim 58 as being anticipated or obvious. Assuming, *arguendo*, that the teaching of Rogers and/or Smith were used to reject claims 58-63, Applicant respectfully submits that the following is taught, shown or disclosed by Rogers and/or Smith:

- at col. 2, lines 55-56, col. 3, lines 36-37, and col. 4, line 47 in Rogers, a thermoplastic strip or bead including a polyvinyl chloride (PVC) plastisol material for a filter material is disclosed; and
- at col. 6, lines 44-50 in Smith, a primed substrate of glass or metal (i.e., for a automotive windshield application) that includes a sealing strip is composed of a liquid polysulfide polymer that is used to prepare a polymer blend with polysulfide rubber.

Accordingly, it is respectfully submitted that Rogers merely discloses a thermoplastic PVC strip or bead. It is respectfully submitted by the Applicant that thermoplastic PVC is not thermoplastic vulcanizate. Smith discloses a seal adhered to glass and/or metal for an automotive windshield application.

As such, the individual teachings of Rogers or Smith do not anticipate or render obvious the claimed teachings of the invention. Assuming, *arguendo*, that the teachings of Rogers and Smith were to be combined, the result of the combination would be an automotive windshield including a thermoplastic PVC strip or bead seal; thus, the combination of Rogers and Smith would not provide a suggestion to one skilled in the art to obtain a seal including TPV that is included with a filter media material. Secondly, and perhaps more importantly, an artisan in Applicant's endeavor would not look to the teachings of Smith for a filter seal and drawing from the reference is therefore not permissible.

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Conclusion

Respectfully, Applicant submits that the Office Action construes the Coffey reference too liberally by only considering, in detail, the limitations recited in former independent claim 26. Among other things, Applicant respectfully submits that the Office Action failed to address many distinguishing limitations not disclosed either expressly or inherently in the prior art. For example, previously-pending dependent claims 30-33 as well as other features recited in independent claims 36 and 37.

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. Favorable consideration and prompt allowance of the application is earnestly solicited. However, if such allowance is not permitted Applicant requests that any subsequent action issued in the present case be marked non-final, for the reasons set forth above.

Any fee due with the filing of the paper is set forth in the attached Amendment Transmittal; however, if any additional fees are due with the filing of this paper, please charge our Deposit Account No. 50-3145, under Order No. 215407-106338 from which the undersigned is authorized to draw.

Dated: 1/9/2007

Respectfully submitted,

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